

Claims 1 and 9

Independent claim 1 is drawn to an image forming method including, *inter alia*, the steps of determining an image composited area of a first original; extracting an image extracted area of a second original; and editing image data so as to composite the image extracted area of the second original into the image. Independent claim 9 is drawn to an image forming system.

Applicant submits that Motosugi fails to disclose each feature recited in claims 1 and 9 and therefore does not anticipate the claims. First, claim 1 describes extracting an image extracted area of a second original to produce image data pertaining to the image extracted area by indicating coordinates of the image extracted area. An explanation of how Motosugi allegedly teaches this feature is not provided in the Office Action. Instead, the Examiner directs Applicant to col. 7, lines 48-51 that discloses an operator which selects an edit area. The Examiner also cites col. 17, lines 17-25 that describes two originals A and B that are read and have their areas calculated. Applicant notes that for a reference to anticipate a claim, the “identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). However, in Motosugi there is no disclosure of any one of A or B having an image extracted area, and instead teaches that original images A and B may merely have different sizes.

The exemplary embodiment of Figure 4, in the present specification, shows an extracted area A1 taken from a second original 41. Such a feature is not disclosed in Motosugi. For example, as shown in Figure 24 of Motosugi, two originals 304 and 305 are provided; the

original 305 is then shown as being overlapped with the original 304 in Figure 25. Applicant submits that none of the original images 304 and 305 would teach the step of extracting an image extracted area of a second original, as in claim 1; or a coordinate device that is capable of indicating an image extracted area, as in claim 9. Instead, the original images 304 and 305 of Motosugi are overlapped as a whole, but do not have an extracted area.

Second, claim 1 describes editing image data so as to composite the image extracted area of the second original into the image composited area of the first original. The image composite area of claim 1 is provided in the “determining” step by indicating coordinates. Applicant submits that Motosugi does not determine an image composited area of the first original 304 by indicating coordinates. Instead, Motosugi merely drags the second original 305 on top of the first image 304 and lacks the claimed step of determining an image composited area of a first original by indicating coordinates of the image composited area. In an exemplary embodiment, the present specification depicts this feature as selecting the area D1 in Figure 3. Applicant, thus, submits that this step is lacking from Motosugi.

Further, because Motosugi does not teach the determining step of claim 1, it necessarily cannot disclose the editing step which composites the image extracted area of the second original into the image composited area of the first original. The editing device features of claim 9 are likewise absent from Motosugi for similar reasons.

Applicant also draws the Examiner’s attention to the “scaling process” as recited in claims 3, 4, 8, 10, 11 and 15, for example. That is, Motosugi fails to disclose a scaling process in

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which the size of an extracted image is scaled to fit the image composite area. An exemplary aspect of these features is described on pages 25 and 26 of the present specification.

Therefore, Applicant submits that Motosugi does not disclose each feature of claims 1 and 9 and requests that the rejection under 35 U.S.C. § 102(b) be withdrawn. The rejection of claims 2-8 and 10-15 should also be withdrawn at least because of these claims respectively depending from claims 1 and 9, and because Motosugi fails to disclose the basic features of the dependent claims that further define claims 1 and 9.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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